

**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Currently, claims 1-3, 7-8, and 12-20 are pending in the present application of which claims 1, 7, 13, and 18 are independent.

Claims 1-3, 7-8, and 12-20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hoffman et al. (U.S. Patent Number 5,613,012) in view of Deo et al. (U.S. Patent Number 5,721,781). The above rejections are respectfully traversed for at least the reasons set forth below.

**Claim Rejection Under 35 U.S.C. §103**

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 1-3, 7-8, and 12-20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hoffman et al. in view of Deo et al. This rejection is respectfully traversed because Hoffman et al. and Deo et al., considered singly or in combination, fail to teach or suggest the claimed invention as set forth in claims 1, 7, 13, 18, and their dependents.

Claims 1, 7, 13, and 18 recite that a remote control for a television or a personal digital assistant (in claim 13) includes a memory that stores a digital signature therein. The Office Action admits that Hoffman et al. does not disclose a remote control that stores digital signatures. “Hoffman discloses the claimed invention except for the storing of a digital signature in a memory of a remote control controller.” See Office Action mailed September 8, 2004, page 3, last paragraph, first line. The Office Action further alleges that Deo et al. “teaches that it is known in the art to store digital signatures in the memory of portable controllers.” See Office Action mailed September 8, 2004, page 3, last paragraph.

The Applicant submits that although Deo et al. discloses the use of a smart card, which may be a portable controller only in the broadest sense of the term “controller,” a smart card is not, by any reasonable interpretation, a remote control for a television or a personal digital assistant--claims 1, 7, and 18 include a remote control and claim 13 includes a personal digital assistant. In addition, there is no way, for example, to use the smart card of Deo et al. to control a television or provide the functionality of a personal digital assistant. Therefore, Deo et al. fails to teach at least this element and the Office Action admits that this element is not shown in Hoffman et al. Accordingly, the Examiner is respectfully requested to allow claims 1, 7, 13, and 18.

At least by virtue of Hoffman et al.’s and Deo et al.’s failure to teach or suggest the above identified element of claims 1, 7, 13, and 18, a *prima facie* case of obviousness has not

been established under 35 U.S.C. § 103. Accordingly, the Examiner is respectfully requested to withdraw the rejection of those claims. Claims 2-3 depend from allowable claim 1; claims 8 and 12 depend from allowable claim 7; claims 14-17 depend from allowable claim 13; and claims 19 and 20 depend from allowable claim 18. These dependent claims are therefore also allowable over Hoffman et al. in view of Deo et al. at least by virtue of their dependencies.

Additionally, the Applicant asserts that there is no motivation to combine the teachings of Hoffman et al. and Deo et al. The Office Action states that “(i)t would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the BIA of Hoffman(et al.) with the storing of the digital signature in the portable device of Deo(et al.) in order to incorporate another type of authentication procedure for protecting and identifying the user.”

However, Hoffman et al.’s entire disclosure expressly teaches against this combination. For example, Hoffman et al. is entitled “Tokenless Identification System For Authorization Of Electronic Transactions And Electronic Transmissions.” Emphasis added. Hoffman et al. also states “(t)here is a need for a computer system that is completely tokenless and that is capable of verifying a user’s personal identity, based solely upon a personal identification code and biometrics that is unique and physically personal to an authorized user, as opposed to verifying an individual’s possession of any physical objects that can be freely transferred between different individuals.” See Column 5 Lines 29-35. Emphasis added.

It is therefore perfectly clear that Hoffman et al. teaches away from storing a digital signature in a memory of a remote control or a personal digital assistant. Not only is there no motivation to combine Hoffman et al. and Deo et al., there is an express and unequivocal

teaching not to combine. Additionally, a combination as suggested by the Office Action would render Hoffman et al. unsuitable for its intended purpose. See MPEP 2143.01, section entitled "The Proposed Modification Cannot Render The Prior Art Unsatisfactory For Its Intended Purpose."

For at least the forgoing reasons, it is respectfully submitted that the Official Action fails to provide a proper motivation to combine Hoffman et al. with Deo et al. and therefore fails to establish that claims 1, 7, 13, and 18 are rendered obvious under 35 U.S.C. § 103. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1, 7, 13, and 18. Claims 2-3 depend from allowable claim 1; claims 8 and 12 depend from allowable claim 7; claims 14-17 depend from allowable claim 13; and claims 19 and 20 depend from allowable claim 18. These dependent claims are therefore also allowable over Hoffman et al. in view of Deo et al. at least by virtue of their dependencies.

### Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

**PATENT**

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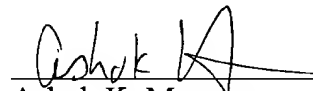
Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

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By



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